

Appl. No.: 09/782,782  
Art Unit: 3711 Docket No.: B01-07  
Reply to Office Action of July 28, 2004

### REMARKS

Claims 1-12, 14-16, 18, 19, 21-28, and new claim 29 appear in this application for the Examiner's review and consideration.

Claims 1 and 18 have been amended to recite the subject matter of claims 13 and 20, respectively, which the Examiner acknowledged were directed to allowable subject matter if re-written in independent form.

Claims 13 and 20 have been cancelled without prejudice to Applicants' right to file one or more continuing applications directed to any subject matter not presently claimed.

Claims 14 and 21 have been amended to correct their dependencies as a result of the amendment to claims 1 and 18.

Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 15, 18, 19, 22, 23, 24, 25, 26, 27, and 28 have been amended to more particularly point out and distinctly claim the inventive subject matter.

New claim 29, which recites the subject matter of claim 15 (which the Examiner also indicated was directed to allowable subject matter) and its base claim, has been added.

No new matter has been added by these amendments and additions.

### Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-16 and 18-28 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. Referring to the decision of the Board, the Examiner states on page 2 of the Office Action that "the term about was rendered indefinite because it is unclear as to [the] scope [the term] about covers."

In an effort to further prosecution of the above-captioned application, Applicants have amended claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 15, 18, 19, 22, 23, 24, 25, 26, 27, and 28 to remove the term 'about'. The rejection under 35 U.S.C. § 112, second paragraph, is therefore believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

It is important to note, however, the Applicants emphatically disagree with the foundation of the rejection and remind the Examiner that it is the Court of Appeals for the Federal Circuit, and not the Board, that sets patent law. Applicants note that case law has repeatedly found the term 'about' to be acceptable claim language and that it should be read in view of the overall specification and prosecution history. Further, Applicants note that the decision of the Board was regarding the use

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of the word 'about' in combination with the claim limitation at issue in the obviousness rejection under appeal. Were this to be read otherwise (*i.e.*, all uses of the term 'about' are indefinite), then the current law is contrary and a large percentage of existing patents have an indefiniteness problem.

#### **Rejection Over Hayashi**

Claims 1-3, 6, 7-12, 16, 18, and 22-27 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,117,026 to Hayashi.

Claims 1 and 18 have been amended to recite the subject matter of claims 13 and 20, respectively, which the Examiner acknowledged were directed to allowable subject matter. The rejection, therefore, is now moot.

For at least the above reasons, independent claims 1 and 18 are believed to be in condition for allowance. Moreover, the dependent claims are believed to be patentable by virtue of their dependence from the independent claims. As such, Applicants respectfully request that the rejection under 35 U.S.C. § 102(a) be reconsidered and withdrawn.

#### **Obviousness-Type Double Patenting Rejection**

Claims 1-11, 16, 18, 19, and 22-26 were rejected under the judicially-created doctrine of obviousness-type double patenting over U.S. Application No. 09/274,015 in view of Hayashi.

While Applicants strongly, but respectfully, disagree with the reasoning of the rejection (the '015 Application contains only method claims having different claim limitations, the only real similarity being that the '015 Application claims are directed to a dual core, double cover golf ball), because claims 1 and 18 have been amended to recite the allowable subject matter of claims 13 and 20, the obviousness-type double patenting rejection is, therefore, moot.

As such, Applicants respectfully request that the obviousness-type double patenting rejection be reconsidered and withdrawn.

#### **CONCLUSION**

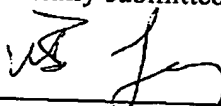
Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' attorney

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would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

No fee is believed to be due for this submission because, while one claim was added, two previously-paid-for claims were cancelled. Should any other required fees be due, however, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,



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